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10/749,697	12/31/2003	Yelena Khandros	2348.0080000	2177

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EXAMINER
BARTLEY, KENNETH

ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
04/22/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/749,697	KHANDROS ET AL.
	Examiner	Art Unit	
	KENNETH L. BARTLEY	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>29 December 2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-16 and 18-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-16 and 18-23</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Receipt of Applicant's amended claims filed December 29, 2008 is
acknowledged.

Response to Amendment

2.   Claims 1, 20, and 23 are amended. Claim 17 has been canceled. Claims 1-16
and 18-23 are pending in the application and are provided to be examined upon their
merits. This is a Non-Final Office Action with a new 35 USC §101 rejection and 35 USC
§112, 1st paragraph rejection not necessitated by the amendments to the claims.

Response to Arguments

3.   Applicant's arguments filed December 29, 2008 have been fully considered but
they are not persuasive. The Examiner provides a response below in **bold**.

Applicant argues 35 USC § 103 rejection, starting pg. 9 of remarks:
Rejections under 35 U.S.C. § 103
In the Office Action the Examiner rejected claims 1-15 and 18 - 23 under 35
U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,790,785
to Klug et al. ("Klug") in view of U.S. Patent No. 7,155,739 to Bari et al. (Bari").
Applicants respectfully traverse.

Applicant argues claim 1:
Claim 1
A. Klug Does Not Teach or Suggest Using Instructions to Detect, on the First
Application, an Indication that the Customer is an Existing Account Holder

The Examiner points out that Bari et al. was used to teach detect.

Claim 1 recites features that distinguish over the applied references.

For example, claim 1 recites, in part, using "instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder."

Barie et al. teaches:
"The invention further monitors a user's network browsing, <u>detects when registration/authentication is needed</u>, and either <u>manually with user intervention or automatically with user permission inputs</u> stored data, or <u>automatically creates the registration/authentication credential data for the user</u>." (Abstract)

Therefore, Barie et al. is teaching detecting by inputs. In doing this, the input acts as an indicator. Separately, regarding indicators, Klug et al. also teaches indicators on forms (Fig. 9, ref. 912)

Further, the Examiner provides a new 35 USC 112, 1st paragraph rejection below regarding "detecting" in the specification and it's not being taught.

The Examiner, on page 8 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 9, lines 14-28 of Klug. The referenced portion of Klug discloses a system whereby "after registering at the registrar web site 100, in step 432, the user is automatically placed in contact with the present third party web so that he/she submits a registration fill-out form to this third party web site 116: (a) indicating that the user's registration information may be obtained from the registrar web site 100; and (b) providing a user 1I) (and optionally a password) for the registrar web site 100 to be used as identification at the present third party web site." (See Klug, col. 9, ll. 14-22)(emphasis added). Thus, Klug discloses a system where the user first registers at the registrar web site, and then secondly is directed to a second web site (i.e., a third party web site) where the user again fills out another registration form, this time from the third party web site. The second registration process at the third party web site includes providing a user ID to the third party web site that identifies the user as a registered user of the registrar web site. Therefore, the third party web site is informed that the user is a registered user of the registrar web site by the user indicating such a status when the user is filling out the second registration form on the third party web site.

From Applicant's comments above…
The Examiner, on page 8 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 9, lines 14-28 of Klug.

If Applicant is referring to the detect feature, pg. 8 specifically states "See "Detect" below" to provide an obviousness rejection using Barie regarding

detecting. Klug was used to teach registration indicates an existing account holder.

> Applicants assert that Klug does not teach or suggest, based on the disclosed indication by the user on the second registration form at the third party web site that the user is a registered user of the registrar web site, at least "instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder," as recited in claim 1.

With all due respect, the Examiner did not argue Klug alone taught…

"instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder,"

Klug was combined with Barie et al. to teach this. The Examiner reminds the Applicant that…

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant continues to argue claim 1, pg. 11 of remarks:
> B. Klug Does Not Teach or Suggest Using Instructions to Transmit a Second Account Application with Fewer Fields Based on the Detection that the Customer is an Existing Account Holder

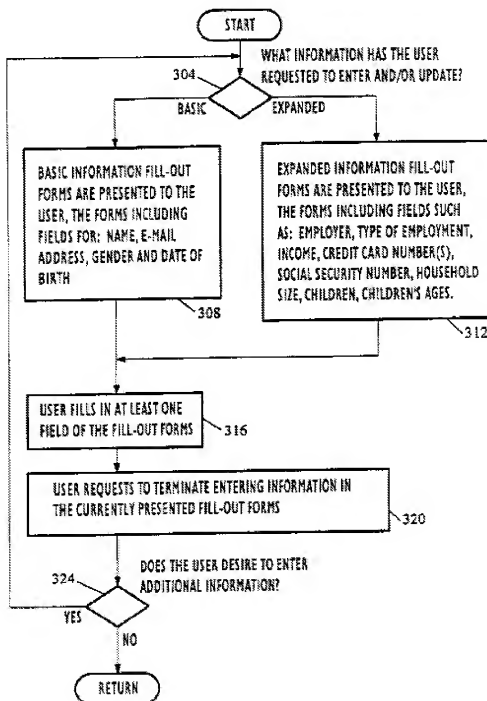**Klug teaches a basic and expanded form (e.g. Fig. 3 below) and Barie et al. teaches detection.**

FIG. 3   USER ENTERS REGISTRAR INFORMATION
(MAY BE INVOKED BY FIGS. 2 AND 12)

START

WHAT INFORMATION HAS THE USER
REQUESTED TO ENTER AND/OR UPDATE?

304

BASIC   EXPANDED

BASIC INFORMATION FILL-OUT
FORMS ARE PRESENTED TO THE
USER, THE FORMS INCLUDING
FIELDS FOR: NAME, E-MAIL
ADDRESS, GENDER AND DATE OF
BIRTH

308

EXPANDED INFORMATION FILL-OUT
FORMS ARE PRESENTED TO THE USER,
THE FORMS INCLUDING FIELDS SUCH
AS: EMPLOYER, TYPE OF EMPLOYMENT,
INCOME, CREDIT CARD NUMBER(S),
SOCIAL SECURITY NUMBER, HOUSEHOLD
SIZE, CHILDREN, CHILDREN'S AGES.

312

USER FILLS IN AT LEAST ONE
FIELD OF THE FILL-OUT FORMS   316

USER REQUESTS TO TERMINATE ENTERING INFORMATION IN
THE CURRENTLY PRESENTED FILL-OUT FORMS   320

DOES THE USER DESIRE TO ENTER
ADDITIONAL INFORMATION?

324

YES

NO

RETURN

Also, claim 1 recites, in part, "instructions to transmit a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application."

The Examiner, on page 9 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 7, line 64 through column 8 line 3 of Klug. This referenced portion of Klug discloses a system in which the user, "when entering web site registration information into the fill-out forms to be submitted to [the] registrar," where "the user determines whether to supply basic information ... or to supply expanded information," (See Klug, col. 7 11.62-67). As disclosed in this section of Klug, the user decides how much registration information to release to the registrar web site, and as stated above, the registrar web site registration is done prior to a third party web site registration, and hence would be considered the first, or initial registration application. Also, on page 9 of the Office action the Examiner states, "[t]herefore, basic information, is provided that has fewer forms compared to the expanded form." Even if this statement is true, to which applicants do not acquiesce, the decision on which form to fill out is made by the user.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the decision on which form to fill out is made by a user and should not be) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claim element referred to above states:
"…instructions to <u>transmit a second account application </u>to the customer, <u>based on successful detection that there is an indication that the customer is an existing account holder</u>, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application;…"

With all due respect, this only requires transmitting a second account application with fewer fields to a customer based on detection that a customer is an existing account holder. There is no limitation on how the second account application is determined. In fact, Applicant's specification (Fig. 1, ref. 106) has customer selecting a link to the short form application.
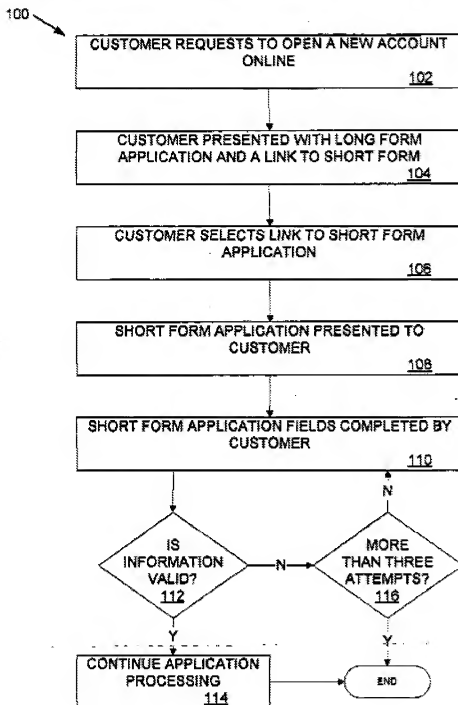
100

```
┌──────────────────────────────────────────┐
│   CUSTOMER REQUESTS TO OPEN A NEW ACCOUNT │
│                  ONLINE                    │
│                                   102      │
└──────────────────────────────────────────┘
                    │
                    ▼
┌──────────────────────────────────────────┐
│   CUSTOMER PRESENTED WITH LONG FORM        │
│   APPLICATION AND A LINK TO SHORT FORM     │
│                                   104      │
└──────────────────────────────────────────┘
                    │
                    ▼
┌──────────────────────────────────────────┐
│   CUSTOMER SELECTS LINK TO SHORT FORM      │
│               APPLICATION                  │
│                                   106      │
└──────────────────────────────────────────┘
                    │
                    ▼
┌──────────────────────────────────────────┐
│   SHORT FORM APPLICATION PRESENTED TO      │
│               CUSTOMER                     │
│                                   108      │
└──────────────────────────────────────────┘
                    │
                    ▼
┌──────────────────────────────────────────┐
│   SHORT FORM APPLICATION FIELDS COMPLETED BY│
│               CUSTOMER                     │
│                                   110      │
└──────────────────────────────────────────┘
         │                            ▲ N
         ▼                            │
    ╱╲                           ╱╲
   ╱  ╲          N              ╱  ╲
  ╱ IS ╲──────────────────────╱ MORE╲
  ╲INFORMATION                 ╲THAN THREE╱
   ╲VALID?╱                     ╲ATTEMPTS?╱
    ╲112╱                         ╲116╱
     │ Y                           │ Y
     ▼                             ▼
┌──────────────────────┐      ╭─────────╮
│ CONTINUE APPLICATION │      │   END   │
│     PROCESSING       │─────▶╰─────────╯
│        114           │
└──────────────────────┘
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FIG. 1

Therefore, Applicants assert that Klug does not teach or suggest, based on the disclosure in Klug that a user decides to provide either basic information or expanded information to a first application, at least "instructions to transmit a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application," as recited in claim 1.

With all due respect, even if Applicant's claim recited the limitation of presenting a shorter new application without the customer having to select an indicator (reading para. 0023 from Pub No. US 2005/0144101 of Applicant's specification), the combined cited references teach Applicant's claimed elements of detecting existing account holders and forms with fewer fields.

Applicant argues Bari et al., pg. 12 of remarks:

C. Bari Does Not Cure The Deficiencies of Klug

Furthermore, Bari does not overcome the deficiencies of Klug. On page 12 of the Office Action the Examiner states, to which Applicants do not acquiesce, that Bari "teaches accounts," in which the "inventive system enables a user to register with the system by creating an account." Thus, Bari is not used to teach or suggest, nor does it teach or suggest, at least the above-recited distinguishing features of claim 1. Therefore, Bari does not cure the deficiencies of Klug, noted above, and the applied references cannot be used to establish a prima facie case of obviousness for pending claim 1.

Bari was used to teach accounts and to detect an existing account holder. Further, ...In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues claims 20 and 23, starting pg. 12 of remarks:

Claims 20 and 23

A. Klug Does Not Teach or Suggest Detecting, on the First Application, an Indication that the Customer is an Existing Account Holder

As provided above, Bari et al. was used to teach detection.

Claims 20 and 23 recite features that distinguish over the applied references. For example, claims 20 and 23 recite, in part, "detecting that there is an indication

that the customer is an existing account holder based on a selection of the selectable indicator associated with the first account application."

The Examiner, on pages 16 and 21 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 9, lines 14-28 of Klug. As discussed above with respect to similar distinguishing features, recited using respective language, in claim 1, this portion of Klug discloses a system whereby "after registering at the registrar web site 100, in step 432, the user is automatically placed in contact with the present third party web so that he/she submits a registration fill-out form to this third party web site 116: (a) indicating that the user's registration information may be obtained from the registrar web site 100; and (b) providing a user ID (and optionally a password) for the registrar web site 100 to be used as identification at the present third party web site." (See Klug, col. 9, 11. 14-22)(emphasis added).

With all due respect, Klug and Bari teach basic and expanded forms and detecting based on inputs that there is an indication that a customer is an existing account holder. Further, Klug teaches…"

For the same reasoning as stated above with respect to similar distinguishing features, recited using respective language, in claim 1, Applicants assert that Klug does not teach or suggest, based on the disclosure in Klug regarding the indication on the second registration form by the user, at least "detecting that there is an indication that the customer is an existing account holder based on a selection of the selectable indicator associated with the first account application," as recited in claims 20 and 23.

Bari was combined with Klug to teach detecting a customer as an existing account holder.

Applicant continues to argue Klug, pg. 13 of remarks:
     B. Klug Does Not Teach or Suggest Transmitting a Second Account Application with Fewer Fields Based on the Detection that the Customer is an Existing Account Holder

Also, claims 20 and 23 recite, in part, "transmitting a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application." The Examiner, on pages 17 and 21 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 7, line 64 through column 8 line 3 of Klug. As discussed above with respect to similar distinguishing features, recited using respective language, in claim 1, this portion of Klug discloses a system in which

the user, "when entering web site registration information into the fill-out forms to be submitted to [the] registrar," where "the user determines whether to supply basic information ... or to supply expanded information," (See Klug, col. 7 11. 62-67). For the same reasoning stated above, with respect to similar distinguishing features, recited using respective language, in claim 1, Applicants assert that Klug does not teach or suggest, based on the disclosure in Klug regarding that the user decides to provide either basic information or expanded information to a first application is not, at least "transmitting a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application," as recited in claims 20 and 23.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the decision on which form to fill out is not made by a user) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also, this only requires transmitting a second account application with fewer fields to a customer based on detection that a customer is an existing account holder. There is no limitation on how the second account application is determined. In fact, as noted above Applicant's specification has customer selecting a link to the short form application.

Applicant argues Bari, page 14 of remarks:
C. Bari Does Not Cure The Deficiencies of Klug
Furthermore, Bari does not overcome the deficiencies of Klug. On pages 18 and 23 of the Office Action the Examiner states, to which Applicants do not acquiesce, that Bari "teaches accounts," in which the "if the user is 'browsing' online, the present invention detects when the user is being asked to enter Authentication credentials," and "how the inventive system enables a user to register with the system by creating an account." Thus, Bari is not used to teach or suggest, nor does it teach or suggest, at least the above-recited distinguishing features of claims 20 and 23. Therefore, Bari does not cure the deficiencies of Klug, noted above, and the applied references cannot be used to establish a prima facie case of obviousness for pending claims 20 and 23.

Bari was used to teach accounts and to detect an existing account holder. Further, ...In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See

In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800
F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant provides a summary of claims 1, 20, and 23, pg. 15 of remarks:
　　　　Accordingly, Applicants respectfully request that the Examiner reconsider and
　　　　withdraw the rejection of claims 1, 20, and 23, and find these claims allowable
　　　　over the applied references. Also, at least based on their respective
　　　　dependencies to claims 1 and 20, claims 2-15, 18, 19, 21, and 22 should be
　　　　found allowable over the applied references, as well as for their additional
　　　　distinguishing features.

**For the reasons cited above regarding the independent claims, the Examiner
respectfully maintains the rejection of these claims.**

Applicant argues claim 16, pg. 15 of remarks:
　　　　Claim 16
　　　　In the Office Action the Examiner rejected claim 16 under 35 U.S.C. § 103(a) as
　　　　being allegedly unpatentable over Klug in view of Bari, and in further view of the
　　　　Official Notice. Applicants respectfully traverse this rejection.

　　　　Claim 16, which ultimately depends from independent claim 1, is also patentable
　　　　over the applied references for reasons similar to those set forth above with
　　　　respect to claim 1, and further in view of their own respective distinguishing
　　　　features.

　　　　Also, Applicants respectfully assert that the Examiner has inappropriately taken
　　　　"Official Notice" because according to the M.P.E.P. at Section 2144.03(A)
　　　　(emphasis added):

　　　　　　　　Official notice without documentary evidence to support an examiner's
　　　　　　　　conclusion is permissible only in some circumstances. While "official
　　　　　　　　notice" may be relied on, these circumstances should be rare when an
　　　　　　　　application is under final rejection or action under 37 CFR 1.113. Official
　　　　　　　　notice unsupported by documentary evidence should only be taken by the
　　　　　　　　examiner where the facts asserted to be well-known, or to be common
　　　　　　　　knowledge in the art are capable of instant and unquestionable
　　　　　　　　demonstration as being well-known.

　　　　In this same Section, the M.P.E.P. then provides some examples of when "official
　　　　notice" was deemed appropriate:

　　　　　　　　In Ahlert, the court held that the Board properly took judicial notice that "it
　　　　　　　　is old to adjust intensity of a flame in accordance with the heat

requirement." See also In re Fox, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new 'audio information' is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

Applicants assert that the features recited in the claim do not fit within one of the narrow exceptions noted by this Section of the M.P.E.P. This Section of the M.P.E.P. also states "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697." Applicants therefore assert that it was inappropriate for the Examiner to take "Official Notice" of without providing documentary evidence.

Applicant is arguing that a checkbox and hyperlink are novel. The Examiner provides the following, reference U.S. Patent No. 6,651,217 to Kennedy et al.:

"Each web site may contain <u>one or more web pages that can be linked and retrieved using conventional protocols</u>. Web pages can also be stored locally on client computer 204." (col. 5, lines 39-42)

"Web pages can include forms that permit a <u>user to enter data</u> into predefined areas (e.g., <u>rectangular boxes</u>, radio buttons, and the like)." (col. 5, lines 43-45)

The Examiner thanks the Applicant for their detailed remarks, however, maintains the rejection.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

According to the recent Guidelines issued by the Deputy Commissioner, in order for a method claim to qualify as a patent eligible process under 35 USC § 101, the process of

the method claim must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such an article or materials) to a different state or thing.

In the instant case, none of the process steps of the method claims are tied to an apparatus such as a computer. Accordingly, the claimed invention fails to qualify as a statutory process under the Guidelines.

The applicant is requested to indicate where in the specification there is support for the amended claim.

Note: merely reciting a computer in the preamble does not meet the aforementioned requirement nor reciting a nominal process such as communicating data with a computer.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention.

7.   Claim 1 is rejected for not following the program algorithm (steps) taught in the

instant application. From the application:

"Turning now to FIG. 1, and with continuing reference to FIGS. 2 and 3, therein is depicted an <u>exemplary process 100 </u>for opening a new account online. The <u>process 100 may be performed</u>, in whole or in part, by an automated system of one or more computers belonging to a financial institution, which includes processors and associated

memories for storing and retrieving <u>programmed processing instructions that implement</u> <u>its various steps</u>. The financial institution's computers are operative to store and retrieve personal information and other financial information about customers in one or more enterprise databases. The financial institution computers are further operative to transmit and receive the information described herein with a customer operating a personal computer, or other device having suitable functionality, over a network." ([0018] of Pub No US 2005/0144101)

100

```
┌─────────────────────────────────────────┐
│  CUSTOMER REQUESTS TO OPEN A NEW ACCOUNT │
│                 ONLINE                    │
│                              102          │
└─────────────────────────────────────────┘
                    │
                    ▼
┌─────────────────────────────────────────┐
│  CUSTOMER PRESENTED WITH LONG FORM        │
│  APPLICATION AND A LINK TO SHORT FORM     │
│                              104          │
└─────────────────────────────────────────┘
                    │
                    ▼
┌─────────────────────────────────────────┐
│  CUSTOMER SELECTS LINK TO SHORT FORM      │
│                APPLICATION                │
│                              106          │
└─────────────────────────────────────────┘
                    │
                    ▼
┌─────────────────────────────────────────┐
│  SHORT FORM APPLICATION PRESENTED TO      │
│                CUSTOMER                    │
│                              108          │
└─────────────────────────────────────────┘
                    │
                    ▼
┌─────────────────────────────────────────┐
│  SHORT FORM APPLICATION FIELDS COMPLETED BY│
│                CUSTOMER                    │
│                              110          │
└─────────────────────────────────────────┘
```

IS INFORMATION VALID? 112

MORE THAN THREE ATTEMPTS? 116

N

CONTINUE APPLICATION PROCESSING 114

END

Y
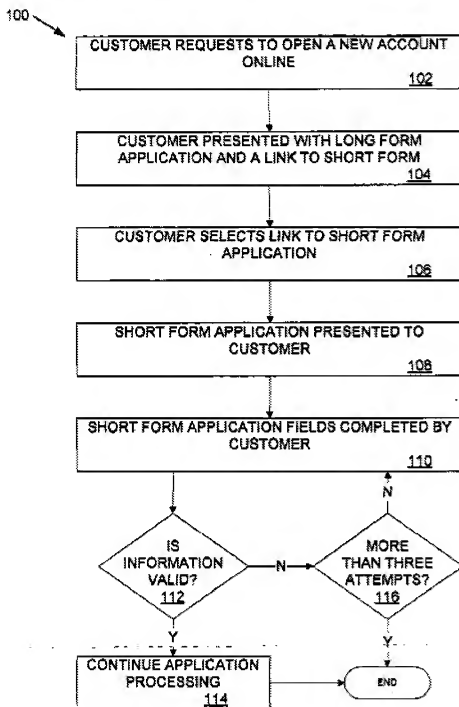
FIG. 1

Claim 1 has steps not supported above:

The above steps teach a program that has:
1. Presenting a customer with a long form and a link to a short form;
2. Selecting the link by a customer to the short form;
3. Presenting the short form to the customer;
4. Completing the short form fields by the customer;
5. Validating the information.

Specifically, regarding the claims:

A. There is <u>no teaching of detecting</u> by the specification. Specifically, claim 1 has...

"instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder;"

However, the specification teaches...
> "Upon a selection of the indicator by the customer (step 106), the financial institution immediately transmits a shorter new account application for presentation to the user (step 108). <u>Alternatively, when the customer has entered an identification of an existing account</u> with the financial institution in the standard new account application, such information <u>may be used to automatically determine</u> that the customer is an existing customer. In such case, the existing customer may then be presented with the shorter new application form without the customer having to select the indicator 202." ([0023] of US 2005/0144101)

There is no teaching or support for <u>detecting based on a plurality of submitted fields</u> that a customer is an existing account holder. There is support for <u>automatically determining</u> that a customer is an <u>existing customer</u> based on a customer entering an <u>identification of an existing account</u>.

B. There is no teaching of "based on successful detection..." above in the instant application. From the 3rd claim step:
"instructions to transmit a second account application to the customer<u>, based on successful detection that there is an indication that the customer is an existing account holder</u>, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application;"

C. Claims 3, 20 and 23 also use detecting or detection and have similar problems.

D. The following dependent claims are not supported by Fig. 1:

Claim 3: where validating step is before transmitting the second application (steps 2

and 3)

Claim 9: where information is transferred from the first to the second application (step

2).

Claim 10: where instructions to retrieve information required for the first account

application and instructions to process the second application based on the retrieved

information (steps 3 and 4).

Claims 11-13: that depends from claim 10.

E. Claims 2-15, 17-19, and 21-22 are rejected because they depend from their

respective independent claims.

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out
> and distinctly claiming the subject matter which the applicant regards as his
> invention.

9.   Claims 20-23 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

10.   Claims 20 and 23 have electronically detecting and electronically transmitting

where there is no apparatus provided to support how electronically is performed (e.g. is

electronically performed by a client computer or at a server and via a network). For

examination purposes, the Examiner assumes Applicant is using a computer to detect

and a network over which transmission occurs.

11.   Claims 21-22 are rejected because they depend from claim 20.

Examiner Request

12.   The Applicant is requested to indicate where in the specification there is support

for amendments to claims should Applicant amend. The purpose of this is to reduce

potential 35 U.S.C. §112, 1st paragraph issues that can arise when claims are amended

without support in the specification. The Examiner thanks the Applicant in advance.

Claim Rejections - 35 USC § 103

13.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

14.   The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

15.   Claims 1-15 and 18-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 5,790,785 to Klug et al. in further view of U.S. Patent

No. 7,155,739 to Bari et al.

Regarding claim 1:
A computer program product comprising a computer usable medium having computer executable instructions recorded thereon, comprising:

> **Klug et al. teaches programming instructions:**
> **As one skilled in the art will appreciate, program modules 128 (hereinafter denoted "registrar applications") output, to a World Wide Web network server 132, information in, for example, a hypertext markup language (HTML) related to capabilities of the registrar web site 100 in assisting the user in registering at third party web sites 116. Such outputs from registrar applications 128, are subsequently transmitted, via the network server 132 and the network interface 136, to the user's WWW browser 120 in the hypertext transfer protocol (HTTP), as one skilled in the art will appreciate. (col. 4, lines 31-41)**

instructions to receive a submitted first account application from a customer, including a plurality of fields associated with personal identification and financial;

> **Klug continues:**
> **"Accordingly, in step 304 the user determines whether to supply basic information (i.e., requested by a substantial number of third party web sites 116) as described in step 308 or to supply expanded information (i.e., more extensive information about the user so that, for example, registrar has sufficient user information to register the user at substantially all cooperating third party web sites 116)." (col. 7, lines 64-67 and col. 8, lines 1-3)**
>
> **Fig. 3, ref. 312 teaches a plurality of fields including credit care number(s) and social security number, which constitutes personal and financial information.**
>
> **Customer has ID and password to log into system to access account (Fig. 2B, ref. 244).**
>
> **See "Account" below**

instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder;

> **"Subsequently, after registering at the registrar web site 100, in step 432, the user is automatically placed in contact with the present third party web site so that he/she submits a registration fill-out form to this third party web site 116: (a) indicating that the user's registration information may be obtained from the registrar web site 100; and (b) providing a user ID (and optionally a password) for the registrar web site 100 to be used as identification at the present third party web site. Following this, in step 436 the third party web site 116 invokes the program corresponding to FIG. 5 to**

obtain the user's registration data from the registrar web site 100. Lastly, <u>upon verification by the third party web site 116 of the user's registration data,</u> the user is granted access to the desired <u>third party web site and/or application</u> (step 440)." (col. 9, lines 14-28)

The submitted registration indicates an existing account holder.

See "Detect" below

instructions to transmit a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application;

"Accordingly, in step 304 the user determines whether to supply <u>basic information</u> (i.e., <u>requested by a substantial number of third party web sites</u> 116) as described in step 308 or to supply expanded information (i.e., more extensive information about the user so that, for example, registrar has sufficient user information to register the user at substantially all cooperating third party web sites 116)." (col. 7, lines 64-67 and col. 8, lines 1-3)

Therefore, basic information, is provided that has fewer forms compared to the expanded form (also Fig. 3, ref. 308 and 312)

instructions to receive a submitted second account application from the customer; and

"Subsequently, once the third party web site 116 has received a response from the user, a determination is made as to whether the user is registered at the web site (step 412). If the user is registered, then no further processing related to the present invention is required. Alternatively, <u>if the user is not registered at the third party web site, then a response is transferred from the third party web site 116 through the World Wide Web 104 to the user's WWW browser 120 providing the user with the fill-out forms in which the user is requested to enter information for registering at the third party web site.</u> Note that if the third party web site 116 is configured to accept user registration information from the present invention, then at least one fill-out form related to registering at the third party web site 116 will request information related to registering the user by using the present invention. In particular, the third party web site 116 may <u>present the user with a fill-out form requesting the user to enter a user ID and optionally a password for the present invention</u> (i.e., registrar) if the user is registered at the registrar web site 100." (col. 8, lines 44-63)

The fill-out form is a second form.

instructions to approve or deny the submitted second account application based on the
information on (i) the submitted second account application and (ii) retrieved stored
information associated with the existing customer.

> **"In particular, the third party web site 116 may <u>present the user with a fill-out form requesting the user to enter a user ID and optionally a password for the present invention</u> (i.e., registrar) if the user is registered at the registrar web site 100." (col. 8, lines 59-63)**

> **"Accordingly, in step 504 the third party web site 116 provides the registrar web site 100 with identification of the third party web site, the user's registrar user ID and (any) registrar password. Further, in some instances, as will be described below, the third party web site 116 also supplies the registrar web site 100 with a return path to the user through the World Wide Web 104. Following this, in step 508, a determination is made by the registrar web site 100 as to whether the <u>third party web site supplied information can be authenticated</u>. If not all third party web site information is authenticated, then step 512 is encountered wherein a determination is made as to whether to request that the third party web site to resend the information of step 504." (col. 9, lines 43-56) Therefore, a submitted second application (Fig. 5, ref. 504) is authenticated (approved or denied) based on the registered information (Fig. 5, ref. 516)**

> <u>Account</u>
> **Klug et al. teaches forms with a user ID that receive personal profile information, such as a name, credit card numbers, and address.**
> **Klug et al. does not teach an account application form.**

> **Bari et al, also in the business of forms with user ID and personal profiles teaches accounts:**

>> **"Specifically, FIG. 5 illustrates how the inventive system enables a user to register with the system by <u>creating an account</u> which includes a personal profile that may detail various data points such as name, email address, physical mailing address, billing address, credit card information, age, gender, birthplace, etc. ("User Profile")." (col. 5, lines 54-59)**

> **It would have been obvious to one of ordinary skill in the art at the time of invention to include with the forms of Klug et al. account forms as taught by Bari et al. since the claimed invention is merely a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.**

Detect
The above combined references teach forms with a user ID that receive
credit card numbers. They also teach accounts.
The above combined references do not teach detecting an existing account
holder based on a plurality of fields.
Bari et al, also in the business of forms with user ID teaches detecting:
    "For example, if a user is "browsing" online, the present invention
    detects when the user is being asked to enter Authentication
    Credentials and other personal profile information in order to
    register and/or use the particular Web site, to order products, to
    process an e-commerce transaction, to pay for a good or service, to
    input shipping information, etc. Additionally, the personal assistant
    application of the present invention seamlessly (to the user),
    securely and automatically checks the user's personalized vault
    database to see if the registration and/or Authentication Credentials
    for the user has already been stored. If so, the personal assistant
    application will automatically fill in the registration and/or
    Authentication Credentials information from the stored data." (col. 9,
    lines 22-35) Inherent with credentials and other information is a
    plurality of fields.

It would have been obvious to one of ordinary skill in the art at the time of
invention to provide a personal assistant to detect a previously registered
user as discussed by Bari et al. in the system of Klug et al. as it is well
within the capabilities of one of ordinary skill in the art at the time of
invention to provide such capability in order to improve the registration
process of Klug with the predicted result of automating the registration
process by automatic detection.

Regarding claim 2:
The computer program product of claim 1, wherein the plurality of fields in the first
account application comprise at least one of:
a customer name field, a customer address field, a field for entering at least a portion of
a government identification number of the customer, a field for entering financial
account information of the customer, a field for entering employment information of the
customer, or a field for entering an annual income of the customer.
    Klug et al. discloses:
    "…the basic information supplied in step 308 (i.e., the user's name, e-mail
    address, gender and date of birth) is also requested in the forms for
    expanded information in step 312." (col. 8, lines 4-7) Klug et al. also
    discloses Fig. 3, ref. 312, which provides for employer name, income, credit
    card number(s) (financial account information), and social security number.

Regarding claim 3:

The computer program product of claim 2, wherein instructions to detect comprises:
receiving information for an existing account in the field for entering financial account
information in the first account application;

> **Klug et al. discloses:**
> **User enters financial account information (credit card numbers is financial**
> **account information) in the first (expanded) form (Fig. 3, ref. 312).**

validating the information for the existing account; and

> **"...a registrar application 128 commences to enrich the**
> **user's supplied registration information with publicly available information**
> **related to the user and, to the degree possible (i.e., conforming with**
> **internet etiquette, privacy concerns of users, and public policy), to verify**
> **the user's registration information." (col. 7, lines 46-51)**

transmitting the second account application after said validating.

> **"Accordingly, in step 304 the user determines whether to supply basic**
> **information (i.e., requested by a substantial number of third party web sites**
> **116) as described in step 308..." (col. 7, lines 64-66).**

Regarding claim 4:
The computer program product of claim 1,
wherein the second account application comprises at least one of:
a customer name field, a field for entering at least a portion of a government
identification number of the customer, a field for entering an account number of an
existing account of the customer, or a field for entering a confirmation number
associated with the existing account.

> **Klug et al. discloses:**
> **"...the basic information supplied in step 308 (i.e., the user's name, e-mail**
> **address, gender and date of birth) is also requested in the forms for**
> **expanded information in step 312." (col. 8, lines 4-7) Klug et al. also**
> **discloses Fig. 3, ref. 312, which provides for employer name, income, credit**
> **card number(s) (financial account information), and social security number.**

Regarding claim 5:
The computer program product of claim 4, wherein the existing account comprises an
existing credit account and the confirmation number associated with the existing
account comprises a credit card identification (CD) number.

> **Klug et al. discloses:**
> **Fig. 3, ref. 312 provides for credit card numbers.**

Regarding claim 6:
The computer program product of claim 1, wherein the second account application
comprises at least one field that is not in the first account application.

> **Klug et al. discloses:**

       Fig. 3, ref. 308 provides for "basic" form with gender.

Regarding claim 7:
The computer program product of claim 1, wherein the second account application
comprises at least one of the plurality of fields of the first new account application.
       Klug et al. discloses:
       **"Note that at least in one embodiment, the basic information supplied in
       step 308 (i.e., the user's name, e-mail address, gender and date of birth) is
       also requested in the forms for expanded information in step 312." (col. 8,
       lines 3-7)**

Regarding claim 8:
The computer program product of claim 7, wherein the first new account application and
the second new account application comprise a customer name field.
       Klug et al. discloses:
       **"Note that at least in one embodiment, the basic information supplied in
       step 308 (i.e., the user's name…) is also requested in the forms for
       expanded information in step 312." (col. 8, lines 3-7)**

Regarding claim 9:
The computer program product of claim 7, further comprising:
instructions to receive information from the customer in the first account application; and
       Klug et al. discloses:
       **"That is, the <u>newly entered registration information is transferred</u> to the
       third party web site 116 by entering into a registrar specific portion of the
       registration form for the third party web site 116 a registrar user
       identification and optionally a password for requesting that the third party
       web site access the registrar web site 100 to obtain the user's registration
       information." (col. 5, lines 38-45)**

instructions to transfer transferring the information from the first account application to
the second account application for the at least one of the plurality of fields that are the
same for the first account application and the second new account application.
       **"Note that at least in one embodiment, the <u>basic information supplied</u> in
       step 308 (i.e., the user's name, e-mail address, gender and date of birth) is
       <u>also requested in the forms for expanded information</u> in step 312. Thus,
       upon filling in at least one field from the fill-out forms (step 316) presented
       in either step 308 or 312 the present invention field checks the user's
       <input> for syntactically appropriate responses." (col. 8, lines 3-10)**

Regarding claim 10:
The computer program product of claim 1, further comprising:
instructions to receive information from the customer for each of the fields of the second
account application;

Klug et al. discloses:
"Basic" information provided by the customer (Fig. 3, ref. 308).

instructions to validate the information received from the customer against data stored
for an existing account of the customer;

**"Subsequently, in step 256 a registrar application 128 commences to
enrich the user's supplied registration information with publicly available
information related to the user and, to the degree possible (i.e., conforming
with internet etiquette, privacy concerns of users, and public policy), to
<u>verify the user's registration information</u>. Note that by <u>comparing the user
supplied information with information about the user from other sources, a
determination can be made as to the accuracy of the user supplied
information</u>." (col. 7, lines 45-54)**

instructions to retrieve information required for the first account application from data
stored for the existing account; and

**Fig. 1 ref. 128 and ref. 144 provides for storing application information that
can be retrieved.**

instructions to process the second account application based on the retrieved
information.

**"Accordingly, in step 304 the user determines whether to supply basic
information (i.e., requested by a substantial number of third party web sites
116) as described in step 308 or to <u>supply expanded information (i.e., more
extensive information about the user so that, for example, registrar has
sufficient user information to register the user at substantially all
cooperating third party web sites 116)</u>." (col. 7, lines 64-67 and col. 8, lines
1-3)**

Regarding claim 11:
The computer program product of claim 10, wherein the instructions to approve or deny
the submitted second account application step(d) is based on said instructions to
process.

**"In particular, the third party web site 116 may <u>present the user with a fill-
out form requesting the user to enter a user ID and optionally a password
for the present invention</u> (i.e., registrar) if the user is registered at the
registrar web site 100." (col. 8, lines 59-63)**

**"Accordingly, in step 504 the third party web site 116 provides the registrar
web site 100 with identification of the third party web site, the user's
registrar user ID and (any) registrar password. Further, in some instances,
as will be described below, the third party web site 116 also supplies the
registrar web site 100 with a return path to the user through the World Wide
Web 104. Following this, in step 508, a determination is made by the**

registrar web site 100 as to whether the third party web site supplied
information can be authenticated. **If not all third party web site information
is authenticated, then step 512 is encountered wherein a determination is
made as to whether to request that the third party web site to resend the
information of step 504." (col. 9, lines 43-56) Therefore, a submitted
second application (Fig. 5, ref. 504) is authenticated (approved or denied)
based on the registered information (Fig. 5, ref. 516)**

Regarding claim 12:
The computer program product of claim 10, further comprising:
instructions to transmit the retrieved information to the customer for confirmation.
> **Klug et al. discloses:**
> **"Alternatively, if discrepancies arise between the user-supplied information
> and other publicly available information about the user, then the user may
> be alerted to these discrepancies and requested to** confirm his/her initial
> responses**." (col. 7, lines 56-60)**

Regarding claim 13:
The computer program product of claim 12, further comprising:
instructions to receive from the customer, one of a confirmation and a correction for the
retrieved information.
> **Klug et al. discloses:**
> **"Alternatively, if discrepancies arise between the user-supplied information
> and other publicly available information about the user, then the user may
> be alerted to these discrepancies and requested to** confirm his/her initial
> responses**." (col. 7, lines 56-60)**

Regarding claims 14 and 15:
(claim 14) The computer program product of claim 1, wherein the first account
application comprises a selectable indication that the customer has an existing account
with the financial institution.
(claim 15) The computer program product of claim 14, further comprising: instructions to
receive a selection of the selectable indicator from the customer.
> **Klug et al. discloses:**
> **Customer has ID and password to log into system to access account (Fig.
> 2B, ref. 244).**

Regarding claim 18:
The computer program product of claim 2, wherein the government identification
number comprises a social security number of the customer.
> **Klug et al. discloses social security number:**
> **Fig. 3, ref. 312**

Regarding claim 19:

The computer program product of claim 1, wherein the instruction to receive the submitted second account application does not utilize a customer login identifier.
> **Klug et al. discloses:**
> **Fig. 3, ref. 308, where the "basic" application can be filled out during the "expanded" application.**

Regarding claim 20:
A method, comprising:
(a) receiving a submitted completed first new account application from a customer, including a plurality of fields associated with personal identification and financial information, the first account application further including a selectable indicator for selection when the customer has an existing account with a financial institution;
> **Klug continues:**
> **"Accordingly, in step 304 the user determines whether to supply basic information (i.e., requested by a substantial number of third party web sites 116) as described in step 308 or to <u>supply expanded information (i.e., more extensive information about the user</u> so that, for example, registrar has sufficient user information to register the user at substantially all cooperating third party web sites 116)." (col. 7, lines 64-67 and col. 8, lines 1-3)**
>
> **Fig. 3, ref. 312 teaches a plurality of fields including credit care number(s) and social security number, which constitutes personal and financial information.**
>
> **Customer has ID and password to log into system to access account (Fig. 2B, ref. 244).**
>
> **See "Account" below**

(b) electronically detecting that there is an indication that the customer is an existing account holder based on a selection of the selectable indicator associated with the first account application;
> **"Subsequently, after registering at the registrar web site 100, in step 432, the user is automatically placed in contact with the present third party web site so that he/she <u>submits a registration fill-out form to this third party web site</u> 116: (a) indicating that the user's registration information may be obtained from the registrar web site 100; and (b) <u>providing a user ID (and optionally a password) for the registrar web site 100</u> to be used as identification at the present third party web site. Following this, in step 436 the third party web site 116 invokes the program corresponding to FIG. 5 to obtain the user's registration data from the registrar web site 100. Lastly, <u>upon verification by the third party web site 116 of the user's registration</u>**

> **data, the user is granted access to the desired <u>third party web site and/or</u> <u>application</u> (step 440)." (col. 9, lines 14-28)**
>
> **The submitted registration indicates an existing account holder.**
>
> **See Detect below**

(c) electronically transmitting a second new account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second new account application including a fewer number of the fields for entering the personal identification and financial information than the first account application;

> **"Accordingly, in step 304 the user determines whether to supply <u>basic</u> <u>information</u> (i.e., <u>requested by a substantial number of third party web sites</u> 116) as described in step 308 or to supply expanded information (i.e., more extensive information about the user so that, for example, registrar has sufficient user information to register the user at substantially all cooperating third party web sites 116)." (col. 7, lines 64-67 and col. 8, lines 1-3)**
>
> **Therefore, basic information, is provided that has fewer forms compared to the expanded form (also Fig. 3, ref. 308 and 312)**

(d) receiving a <u>submitted</u> second account application from the customer; and

> **"Subsequently, once the third party web site 116 has received a response from the user, a determination is made as to whether the user is registered at the web site (step 412). If the user is registered, then no further processing related to the present invention is required. Alternatively, <u>if the</u> <u>user is not registered at the third party web site, then a response is</u> <u>transferred from the third party web site 116 through the World Wide Web</u> <u>104 to the user's WWW browser 120 providing the user with the fill-out</u> <u>forms in which the user is requested to enter information for registering at</u> <u>the third party web site</u>. Note that if the third party web site 116 is configured to accept user registration information from the present invention, then at least one fill-out form related to registering at the third party web site 116 will request information related to registering the user by using the present invention. In particular, the third party web site 116 may <u>present the user with a fill-out form requesting the user to enter a user</u> <u>ID and optionally a password for the present invention</u> (i.e., registrar) if the user is registered at the registrar web site 100." (col. 8, lines 44-59) The fill-out form is a second form.**

(e) approving or denying the submitted second account application based on the information on (i) the submitted second account application and (ii) retrieved stored information associated with the existing customer.

> "In particular, the third party web site 116 may present the user with a fill-out form requesting the user to enter a user ID and optionally a password for the present invention (i.e., registrar) if the user is registered at the registrar web site 100." (col. 8, lines 59-63)

> "Accordingly, in step 504 the third party web site 116 provides the registrar web site 100 with identification of the third party web site, the user's registrar user ID and (any) registrar password. Further, in some instances, as will be described below, the third party web site 116 also supplies the registrar web site 100 with a return path to the user through the World Wide Web 104. Following this, in step 508, a determination is made by the registrar web site 100 as to whether the third party web site supplied information can be authenticated. If not all third party web site information is authenticated, then step 512 is encountered wherein a determination is made as to whether to request that the third party web site to resend the information of step 504." (col. 9, lines 43-56) Therefore, a submitted second application (Fig. 5, ref. 504) is authenticated (approved or denied) based on the registered information (Fig. 5, ref. 516)

Account
Klug et al. teaches forms with a user ID that receive personal profile information, such as a name, credit card numbers, and address.
Klug et al. does not teach an account application form.

Bari et al, also in the business of forms with user ID and personal profiles teaches accounts:

> "Specifically, FIG. 5 illustrates how the inventive system enables a user to register with the system by creating an account which includes a personal profile that may detail various data points such as name, email address, physical mailing address, billing address, credit card information, age, gender, birthplace, etc. ("User Profile")." (col. 5, lines 54-59)

It would have been obvious to one of ordinary skill I the art at the time of invention to include with the forms of Klug et al. account forms as taught by Bari et al. since the claimed invention is merely a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Detect

The above combined references teach forms with a user ID that receive credit card numbers. They also teach accounts.

The above combined references do not teach detecting an existing account holder based on a plurality of fields.

Bari et al, also in the business of forms with user ID teaches detecting:

> "For example, if a user is "browsing" online, the present invention detects when the user is being asked to enter Authentication Credentials and other personal profile information in order to register and/or use the particular Web site, to order products, to process an e-commerce transaction, to pay for a good or service, to input shipping information, etc. Additionally, the personal assistant application of the present invention seamlessly (to the user), securely and automatically checks the user's personalized vault database to see if the registration and/or Authentication Credentials for the user has already been stored. If so, the personal assistant application will automatically fill in the registration and/or Authentication Credentials information from the stored data." (col. 9, lines 22-35) Inherent with credentials and other information is a plurality of fields.

It would have been obvious to one of ordinary skill in the art at the time of invention to provide a personal assistant to detect a previously registered user as discussed by Bari et al. in the system of Klug et al. as it is well within the capabilities of one of ordinary skill in the art at the time of invention to provide such capability in order to improve the registration process of Klug with the predicted result of automating the registration process by automatic detection.

Regarding claim 21:

The method of claim 20, further comprising:

(f) receiving information from the customer for each of the fields of the second account application, the information including an identification of the existing account;

> **Klug et al. discloses:**
> "…custom information, wherein selected fields from the basic and expanded information are provided;" (col. 10, lines 4-6) Therefore, a custom form with account information is available.
>
> Fig. 3, ref. 312 teaches credit card numbers.

(g) validating the information received from the customer against data stored for the existing account;

> "Subsequently, in step 256 a registrar application 128 commences to enrich the user's supplied registration information with publicly available information related to the user and, to the degree possible (i.e., conforming

      **with internet etiquette, privacy concerns of users, and public policy), to
      <u>verify the user's registration information</u>. Note that by comparing the user
      supplied information with information about the user from other sources, a
      determination can be made as to the accuracy of the user supplied
      information." (col. 7, lines 45-54)**

(h) retrieving additional information required for the first new account application from
data stored for the existing account; and
      **"The new web site subsequently is able to automatically retrieve the user's
      registration information from the registration web site and register the user
      at the new web site." (col. 2, lines 33-36)**

processing the second new account application based on the retrieved additional
information.
      **"Therefore, it would be advantageous to alleviate many of the above
      difficulties by automating the registration process at web sites so that
      users may register at a single web site and use the information provided at
      this web site to more easily register at other web sites." (col. 1, lines 53-57)**

<u>Regarding claim 22:</u>
The method of claim 20, further comprising:
(f) receiving information from the customer in the first account application; and
      <u>**Klug et al. discloses:**</u>
      **"Subsequently, after the user's request to supply registration information
      is transmitted to the registrar web site 100 (via World Wide Web 104,
      network interface 136 and network server 132), the <u>registrar applications
      128 receive the request</u>…" (col. 4, lines 48-51)**

(g) transferring the information from the first account application to the second account
application for at least one field that is provided in both the first account application and
the second account application.
      **"Note that at least in one embodiment, the basic information supplied in
      step 308 (i.e., the user's name, e-mail address, gender and date of birth) is
      <u>also requested in the forms for expanded information</u> in step 312." (col. 8,
      lines 3-7)**

      **Also,
      "Thus, the user's registration information automatically is communicated
      to the third party web site 116 without the user explicitly having to navigate
      the World Wide Web 104 and access the registrar web site 100 to register
      his/her web site registration information." (col. 5, lines 45-49) Fig. 1, ref.
      128 and 144 show different applications having access to the same
      database, therefore, it would be inherent that the same field on two**

different forms that can be given to a third party (basic or expanded)
access the same information.

Regarding claim 23:

A method, comprising:

(a) receiving a submitted completed first account application from a customer, including
a plurality of fields associated with personal identification and financial information, the
first account application further comprising a selectable indicator for selection by
customers having an existing account with a financial institution;

Klug et al. discloses:

**Customer has ID and password to log into system to access account (Fig.
2B, ref. 244).**

**An expanded account application, that includes personal identification and
financial information (e.g. income) of a customer (Fig. 3, ref. 312).**

**"Accordingly, in step 304 the user determines whether to supply basic
information (i.e., requested by a substantial number of third party web sites
116) as described in step 308 or to supply expanded information…" (col. 7,
lines 64-67)**

See "Account" below.

(b) electronically detecting that there is an indication that the customer is an existing
account holder based on a selection of the selectable indicator associated with the first
account application;

**"Subsequently, after registering at the registrar web site 100, in step 432,
the user is automatically placed in contact with the present third party web
site so that he/she submits a registration fill-out form to this third party
web site 116: (a) indicating that the user's registration information may be
obtained from the registrar web site 100; and (b) providing a user ID (and
optionally a password) for the registrar web site 100 to be used as
identification at the present third party web site. Following this, in step 436
the third party web site 116 invokes the program corresponding to FIG. 5 to
obtain the user's registration data from the registrar web site 100. Lastly,
upon verification by the third party web site 116 of the user's registration
data, the user is granted access to the desired third party web site and/or
application (step 440)." (col. 9, lines 14-28)**

The submitted registration indicates an existing account holder.

See "Detect" below.

(c) electronically transmitting a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application;

> **"Accordingly, in step 304 the user determines whether to supply <u>basic information</u> (i.e., <u>requested by a substantial number of third party web sites 116</u>) as described in step 308 or to supply expanded information (i.e., more extensive information about the user so that, for example, registrar has sufficient user information to register the user at substantially all cooperating third party web sites 116)." (col. 7, lines 64-67 and col. 8, lines 1-3)**

> **Therefore, basic information, is provided that has fewer forms compared to the expanded form (also Fig. 3, ref. 308 and 312)**

(d) transferring any data entered by the customer in the first account application to a similar field of the second account application;

> **"Note that at least in one embodiment, the basic information supplied in step 308 (i.e., the user's name, e-mail address, gender and date of birth) is also requested in the forms for expanded information in step 312. Thus, upon filling in at least one field from the fill-out forms (step 316) presented in either step 308 or 312 the present invention field checks the user's <input> for syntactically appropriate responses." (col. 8, lines 3-10)**

(e) receiving, from the customer, remaining information, for the second account application;

> **A customer has the opportunity to input other information (e.g. e-mail) into a "basic" form for example (Fig. 3, ref. 308)**

(f) retrieving information stored for the existing account to process the second account application; and

> **"Subsequently, once the third party web site 116 has received a response from the user, a determination is made as to whether the user is registered at the web site (step 412). If the user is registered, then no further processing related to the present invention is required. Alternatively, <u>if the user is not registered at the third party web site, then a response is transferred from the third party web site 116 through the World Wide Web 104 to the user's WWW browser 120 providing the user with the fill-out forms in which the user is requested to enter information for registering at the third party web site</u>. Note that if the third party web site 116 is configured to accept user registration information from the present invention, then at least one fill-out form related to registering at the third party web site 116 will request information related to registering the user**

by using the present invention. In particular, the third party web site 116
may <u>present the user with a fill-out form requesting the user to enter a user
ID and optionally a password for the present invention</u> (i.e., registrar) if the
user is registered at the registrar web site 100." (col. 8, lines 44-59) The fill-
out form is a second form.

(g) approving or denying the <u>submitted</u> second account application based on the
information on(i) the <u>submitted</u> second account application and (ii) retrieved stored
information associated with the existing customer.
"In particular, the third party web site 116 may <u>present the user with a fill-
out form requesting the user to enter a user ID and optionally a password
for the present invention</u> (i.e., registrar) if the user is registered at the
registrar web site 100." (col. 8, lines 59-63)

"Accordingly, in step 504 the third party web site 116 provides the registrar
web site 100 with identification of the third party web site, the user's
registrar user ID and (any) registrar password. Further, in some instances,
as will be described below, the third party web site 116 also supplies the
registrar web site 100 with a return path to the user through the World Wide
Web 104. Following this, in step 508, a determination is made by the
registrar web site 100 as to whether the <u>third party web site supplied
information can be authenticated</u>. If not all third party web site information
is authenticated, then step 512 is encountered wherein a determination is
made as to whether to request that the third party web site to resend the
information of step 504." (col. 9, lines 43-56) Therefore, a submitted
second application (Fig. 5, ref. 504) is authenticated (approved or denied)
based on the registered information (Fig. 5, ref. 516)

<u>Account</u>
Klug et al. teaches forms with a user ID that receive personal profile
information, such as a name, credit card numbers, and address.
Klug et al. does not teach an account application form.

Bari et al, also in the business of forms with user ID and personal profiles
teaches accounts:
"Specifically, FIG. 5 illustrates how the inventive system enables a
user to register with the system by <u>creating an account</u> which
includes a personal profile that may detail various data points such
as name, email address, physical mailing address, billing address,
credit card information, age, gender, birthplace, etc. ("User Profile")."
(col. 5, lines 54-59)

It would have been obvious to one of ordinary skill I the art at the time of
invention to include with the forms of Klug et al. account forms as taught

by Bari et al. since the claimed invention is merely a combination of old elements and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Detect
The above combined references teach forms with a user ID that receive credit card numbers. They also teach accounts.
The above combined references do not teach detecting an existing account holder based on a plurality of fields.
Bari et al, also in the business of forms with user ID teaches detecting:
> "For example, if a user is "browsing" online, the present invention <u>detects when the user is being asked to enter Authentication Credentials</u> and other personal profile information in order to register and/or use the particular Web site, to order products, to process an e-commerce transaction, to pay for a good or service, to input shipping information, etc. Additionally, <u>the personal assistant application of the present invention seamlessly (to the user), securely and automatically checks the user's personalized vault database to see if the registration and/or Authentication Credentials</u> for the user has already been stored. If so, the personal assistant application will automatically fill in the registration and/or Authentication Credentials information from the stored data." (col. 9, lines 22-35) Inherent with credentials and other information is a plurality of fields.

It would have been obvious to one of ordinary skill in the art at the time of invention to provide a personal assistant to detect a previously registered user as discussed by Bari et al. in the system of Klug et al. as it is well within the capabilities of one of ordinary skill in the art at the time of invention to provide such capability in order to improve the registration process of Klug with the predicted result of automating the registration process by automatic detection.

16.   Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the

combined references in section (15) above in further view of Official Notice.

<u>Claim 16:</u>
The computer program product of claim 14, wherein the selectable indication comprises at least one of a checkbox and a hyperlink.
> **While Klug et al. teaches different forms and a selectable indication, he does not teach checkbox or hyperlink. However, the Examiner takes**

Official Notice that use of a hyperlink, for example, as a selectable indication is old and well known. Therefore, it would have been obvious to one skilled in the art at the time of invention to include a hyperlink as a selectable indication, and that this would allow for easily moving form the expanded form offered by Klug et al. to their basic form.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

U.S. Patent No.	6,088,700	Larsen et al.
U.S. Pub. No.	2007/0244805	Wiryawan et al.
U.S. Patent No.	7,334,187	Stanciu et al.
U.S. Pub. No.	2002/0013788	Pennell et al.
U.S. Pub. No.	2002/0077970	Lebda et al.
U.S. Patent No.	6,385,594	Lebda et al.
U.S. Pub. No.	2003/0233316	Hu et al.
U.S. Patent No.	6,192,380	Light et al.

18.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENNETH L. BARTLEY whose telephone number is (571)272-5230. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jagdish Patel can be reached on (571) 272-6748. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAGDISH N PATEL/

Acting Examiner of Art Unit 3693